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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,474	10/14/2003	Shahla C. Cisneros	PD-203019	8877
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THE DIRECTV GROUP INC			BOND, CHRISTOPHER H	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/687,474	CISNEROS ET AL.
	Examiner	Art Unit
	Christopher H. Bond	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 March 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-14 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-14 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 14 October 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

1. The arguments and amendments have been entered on March 9, 2007.

Claims 1-14 are still pending in the present application.

Specification

2. The amendment filed March 9, 2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: A plurality of games stored on the set top box (STB).

3. Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

4. Claims 1 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. The applicants disclose that the gaming portal is stored at the receiver, and also disclose a gaming system and the plurality of games are stored at the plurality of receivers. While applicant discloses in paragraph [0030] that, "The questions and gaming application for playing the trivia game reside in the user's STB...", there is nowhere in the disclosure that applicants mention or suggest

that either a gaming portal is stored at the receiver or a plurality of games are stored on the set top box (STB). Furthermore, applicants' abstract discloses that, "The gaming system (25) provides a plurality of games...where the gaming system is a wholly separate and unique part of the invention residing within the central broadcast center, and not part of the STB.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

8. Regarding claim 1, applicant has amended the claim to include limitation "storing the gaming portal at the receiver." However, applicant fails to disclose in the specification that the gaming portal is stored at the receiver. The gaming portal as referenced in applicant's specification (paragraph [0042]) is used to 'select' the interactive trivia game, and it is understood by those skilled in the art that a portal would serve as an entry means, 'start screen', or serve as a means for connecting the user to the game system from the set top box—further indicated by applicant's Figure 3. Additionally, applicant only references the receiver in the specification (paragraph [0036]), reference number 22c, as something that receives the commands from the handheld device and relays these commands to the STB gaming application. Furthermore, applicant discloses (paragraph [0030]) that only 'the questions and gaming application for playing the trivia game reside in the user's STB.' While it is noted that the

Examiner understands that the gaming portal is part of the gaming application, the Examiner, for examination purposes, will interpret applicant's claim of 'storing the gaming portal at the receiver' to mean 'storing the gaming application in the set top box (STB).'

9. Regarding claim 8, again, the Examiner has interpreted applicant's 'receiver' to mean 'STB': Gaming system, as referenced in the applicant's specification (paragraph [0030] and Figure 1A) is defined as, "A gaming system 25 includes a question database 12 for use with a game application 14, such as an application for a trivia game. The gaming system 25 transmits data from the question database 12 and the trivia application 14 to a real-time update server 16. The update server 16 transmits data to an uplink server 18 that relays the data to a satellite 20. The satellite 20 then transmits the data from the question database 12 and/or game application 14 to a user's television STB 22." This gaming system is wholly separate from the applicant's STB—while the question database **12** and game application **14** of the gaming system are also separate and unique from the STB database **221** and gaming application **223** of the STB. As the gaming system resides within the central broadcast center, with further limitation of having a plurality of games accessible through the gaming system, wherein the gaming system and the plurality of games are stored at the plurality of receivers—the gaming system cannot be stored on both the server and receiver as this is not disclosed in the applicants' limitation. The limitation of claim 8 which states, "wherein the gaming system and plurality of games are

stored at the plurality of receivers" is interpreted by the Examiner to mean, "gaming application stored at the plurality of STBs."

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over NTN Communications Inc 10-K SEC Filing of March 6,2002 (NTN).**

12. NTN discloses (page 2), 'The NTN Network is North America's largest...interactive television network. [The]...network broadcasts a variety of interactive multi-player sports and trivia games...365 days per year..." (equivalent to applicant's limitation of interactive gaming). NTN further discloses (page 4), "[NTN network]...develop[s] and produce[s] original programming at our facilities...for distribution to our sites...We can provide simultaneous transmission of up to 16 live events for interactive play and a multitude of interactive games and other programs, allowing distribution of different programs to customers in different geographical locations" (equivalent to applicant's limitation of a central broadcast center over a first communications network and a game system residing within the central broadcast center). NTN further discloses (page 4) that

they, "...use either satellite or Internet service providers to distribute our programming to our customers" (equivalent to applicant's limitation of having a plurality of users who access the gaming system via the first communications network). NTN discloses (page 3), "The NTN Network features games licensed pursuant to a perpetual non-exclusive license agreement from Buzztime. [They]...generally broadcast premium trivia competitions ... and live interactive sports-oriented play-along games..." (equivalent to applicant's limitation of providing a plurality of games accessible through the gaming system). NTN then discloses (page 3), "The NTN Network's interactive programming permits players to compete in real-time within each location and to be ranked against players in all locations throughout North America. At the conclusion of each game broadcast, players' scores are calculated and top scores are sent via phone lines to our broadcast center...Within minutes, rankings for each location are tabulated and displayed and rankings and scores for the top locations are transmitted back to all locations via the NTN Network for display" (equivalent to applicant's limitation of a scoring protocol where scoring is provided in real-time back to the gaming system via a second communication network).

13. In regards to the applicant's amended claim of having the gaming application and plurality of games stored on the set top box, this would have been an obvious limitation, as one skilled in the art would readily recognize that storing both the game application and plurality of games could be accomplished using memory (RAM) or other similar storage device.

14. **Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over NTN in view of Walker et al., USPAT 5,779,549 (Walker) and further in view of Weitz, USPUB 2003/0171148 (Weitz).**

15. In regards to claim 9, NTN discloses (page 3), "The NTN Network features games licensed pursuant to a perpetual non-exclusive license agreement from Buzztime. [They]...generally broadcast premium trivia competitions ... and live interactive sports-oriented play-along games..." (equivalent to applicant's limitation of having a gaming application associated with each of the plurality of games). NTN further discloses (page 4) that, "...[their] facilities are equipped with video, satellite and communications equipment, and...multimedia site server computers" (equivalent to applicant's uplink server). NTN also discloses (page 5), "Game servers...[used] to execute the games..." It's obvious these servers would serve as an uplink server to transmit content from their production studio game servers to the players. NTN however, fails to explicitly disclose any information regarding the question database, a scoring database, as well as any information regarding a real-time update server. NTN also discloses (page 5) that the game servers, "execute the games and collect user statistics...")

16. Walker discloses (column 10, lines 50-54) that, "Linked to the tournament database would be a database devoted to storing questions and answers, from which trivia tournaments would extract questions." He further discloses, (column 12, line 24), "Databases of...scores..."

17. The advantage of using a database, Walker writes (column 10, lines 60-67), is that, "...[the] last database field is especially important given the time and

expense associated with creating questions and answers, since the re-use of some questions is almost inevitable. While tournament organizers obviously do not want to have players seeing questions for the second time, they also do not want to throw out a question that only a small percentage of potential tournament participants have seen. Databases provide the best compromise...". The advantage of using a score database, Walker writes (column 12, lines 24-25), is to, "...allow [players]...to check the comparability of their scores."

18. This is evidence that one of ordinary skill in the art would find a reason/motivation/suggestion to use a question database to help eliminate the time and expense of generating questions, to prevent the re-use of question, and to prevent the loss of questions as well as using a score database to allow players to compare their scores.

19. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of NTN by implementing the question and score databases as described by Walker for the purpose of eliminating the time and expense associated with generating questions, to prevent the re-use of questions, and to prevent the loss of questions, and to allow players to compare their scores.

20. Still lacking is the limitation such as the real-time update server where the real-time update server receives and transmits data.

21. Weitz discloses, (paragraph [0011]), "...a plurality of...servers, receiving real-time updates from the...source, and using the cross-broadcast real-time

upload means to choose at least one of the...servers and to upload the real-time updates to the chosen...server(s)..."

22. The advantage of using real-time update servers, Wetiz writes, (paragraph [0007]) is, "...to have real-time online communication between the application running on the set-top box (e.g. a game) and the headend."

23. This is evidence that one of ordinary skill in the art would find a reason/motivation/suggestion to use real-time update servers for real-time communications between the STB and the headend.

24. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of NTN when modified by Walker with the real-time update server as described by Weitz for the purpose of providing real-time communication between the STB and the headend.

25. As to claims 10 and 11, NTN discloses (page 2-3) that, "Each subscribing hospitality location is furnished with...proprietary equipment, including a customized site server computer, a satellite data-receiving unit, and an average of 14 Playmakers, which players use to enter their game play selections" (this is equivalent to the applicant's limitation of having a user reception device that receives signals from the uplink server). Signals are received via satellite, and as previously mentioned, signals are sent to the broadcast center via phone lines, which meets the applicant's limitation of transmitting signals to the gaming system via a second communications network. NTN's interactive content is distributed to the data receiving unit (applicant's reception device) which has access to the game server (applicant's question database). NTN further discloses

(page 2) that, "Patrons use our hand-held wireless Playmaker devices to interact with trivia and sports games displayed on television screens in the hospitality location," and further discloses (page 2), "The...Playmakers also feature a larger, eight line LCD screen that displays sports scores and other ticker information and enable electronic, text-based chat between patrons" (equivalent to applicant's limitation of having a user input device that receives signals from the reception device and is capable of transmitting signals to the reception device).

26. **Claims 1, 2, 12 and 13 are rejected under 35 U.S.C 103(a) as being unpatentable over NTN in view of Junkin, USPAT 6,193,610 (Junkin).**

27. What is disclosed in NTN is discussed above and incorporated herein.

28. NTN also discloses (page 5), "Web servers...used to connect the user to our web sites...[and] Login and registration servers...[that] allow a user to register and/or log in to our web sites" (equivalent to applicant's limitation of submitting user identification). NTN further discloses (page 7) "Countdown", one of their interactive trivia games. Countdown is one of NTN's longest-running trivia games, and it is well known by people familiar with the art, that Countdown uses a time-based scoring component. The game uses 15 questions, each with five possible answers, on a variety of topics. Players can earn up to 1,000 points per question based on how fast they answer; the number of points decrease as time passes. Clues are given to help the player eliminate incorrect choices, with the third clue usually alluding to what the correct answer is. The answer is given once time runs out. A score of 15,000 is considered a "perfect" score.

29. However, NTN fails to explicitly disclose a bonus score component or different skill levels.

30. Junkin discloses (column 7, 35-39) that, "The player score calculation may provide for the weighting of certain statistics depending on the importance, difficulty or occurrence rate of each statistic. In addition, the player score may be uniquely tailored to accommodate a particular event. Junkin further discloses, (column 11, lines 17-24) that, "...a certain skill factor is involved...The menu...allows the participant to be involved in different levels of the interactive game. The may be a beginners level, intermediate level and advanced level."

31. The advantage of using bonus scoring and different skill levels, Junkin writes, (column 1, lines 33-44) is, "...increasing the enjoyment of an interactive game...[and] increasing the level of skill and knowledge of a participant..."

32. This is evidence that one of ordinary skill in the art would have reason/motivation/suggestion to use bonus scoring and different skill levels in an interactive television gaming system for the increasing enjoyment, skill level, and knowledge of the participant.

33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of NTN with the bonus scoring and different skill level component as described by Junkin for the purpose of increasing the enjoyment, skill level, and knowledge of the participant.

34. Further, the method of interactive gaming and method of calculating a time based component disclosed by the applicant merely discloses the steps of the interactive gaming devices operation, and since each element must be

implemented in order to make the device, the method would have at least been obvious in view of the device.

35. As to applicants' new limitation of storing a gaming portal at the STB, one skilled in the art would recognize that storing a gaming portal could easily be accomplished by using memory (RAM).

36. Accordingly, claims 1,2,12, and 13 would have been obvious.

37. **Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over NTN in view of Junkin, and further in view of Walker.**

38. In regards to claims 4-7, the method of initiating a game, generating a plurality of questions, initiating a question/answer sequence, and managing the questions, as disclosed by the applicant, merely discloses the steps of performing these functions, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

39. NTN when modified by Junkin fails to explicitly disclose any information regarding the question database, a scoring database, as well as any information regarding a real-time update server. NTN also discloses (page 5) that the game servers, "execute the games and collect user statistics...")

40. Walker discloses (column 10, lines 50-54) that, "Linked to the tournament database would be a database devoted to storing questions and answers, from which trivia tournaments would extract questions." He further discloses, (column 12, line 24), "Databases of...scores..."

41. The advantage of using a database, Walker writes (column 10, lines 60-67), is that, "...[the] last database field is especially important given the time and expense associated with creating questions and answers, since the re-use of some questions is almost inevitable. While tournament organizers obviously do not want to have players seeing questions for the second time, they also do not want to throw out a question that only a small percentage of potential tournament participants have seen. Databases provide the best compromise...". The advantage of using a score database, Walker writes (column 12, lines 24-25), is to, "...allow [players]...to check the comparability of their scores."

42. This is evidence that one of ordinary skill in the art would find a reason/motivation/suggestion to use a question database to help eliminate the time and expense of generating questions, to prevent the re-use of question, and to prevent the loss of questions, as well as using a score database to allow players to compare their scores.

43. Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of NTN by implementing the question and score databases as described by Walker for the purpose of eliminating the time and expense associated with generating questions, to prevent the re-use of questions, and to prevent the loss of questions, and to allow players to compare their scores.

44. **Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over NTN in view of Junkin, and further in view of Crockett et al., USPUB 2004/0039631, (Crockett).**

45. NTN's invention when viewed in conjunction with Junkin discloses bonus scoring, but does not explicitly disclose the bonus score components.

46. Crocket discloses (pages 3-4, paragraph [0038]), "...[a] weighted score is calculated by multiplying the...weighted score...by the ratio of the...score over the maximum possible...score."

47. The advantage of calculating the bonus score in this way, Crockett states (page 1, paragraph [0004]), "...enable[s] an organization to attract, retain, and develop desired customers and optimize the value of each of these customer relationships."

48. This is evidence that one of ordinary skill in the art would have reason/motivation/suggestion to use these components in calculating the bonus score in an interactive television gaming system for the purpose of attracting, retaining, and developing customers.

49. Therefore, it would be obvious to anyone of ordinary skill in the art at the time of the invention was made to modify NTN when modified by Junkin with the bonus score component as claimed for the purpose of customer attraction, retention and development, as suggested by Crockett.

50. As per claim 3 the method of calculating a bonus score component disclosed by the applicant merely discloses the steps of the interactive gaming device's operation, and since each element must be implemented in order to make the device, the method would have been obvious in view of the device.

Response to Arguments

51. Examiner's previous 35 U.S.C. 101 rejection has been withdrawn due to the satisfactory amendment made by the applicant.

52. Applicant's arguments filed March 9, 2007 have been fully considered but they are not persuasive.

53. In regards to applicant's argument that 'the cited references do not teach nor suggest these various elements of applicants' independent claims. Specifically, the cited reference do not teach nor suggest at least the limitation of the gaming system and the plurality of games being stored at the plurality of receivers as recited in the claims of the present invention, it is once again respectfully pointed out to the applicants by the Examiner that the applicants' specification specifically states (paragraph [0032]), "The questions and gaming application for playing the trivia game reside in the user's STB." As previously discussed by the Examiner, the gaming system and receiver, as disclosed by the applicant, are completely and wholly different than the gaming application and STB used in the applicants' argument. Furthermore, even examined as a whole, the added limitation of storing games and a gaming application on a set top box offers nothing novel to the applicants' invention as this has been notoriously obvious to those skilled in the art—gaming consoles being a common example. Moreover, NTN's SEC filing also anticipates this argument (page 9, last paragraph) in stating that, "...competition within the interactive television space comes from three or four existing game providers that are also seeking to provide games on digital set top boxes, either as single play or networked games...most

of these competitors can only offer stand-alone single player games on current set-tops. Thus, a stand-alone game would not require a network, and as such would require that the game be located at the receiver—in this case, the set top box.

54. In regards to applicants' argument that the combined NTN and Junkin references teach a system that performs a live broadcast and that the present invention does not rely on a live broadcast, or on an online simultaneous transmission to provide a gaming experience to viewers, and that the gaming portal can be updated with new questions periodically without rebroadcasting the game itself, while NTN and the ancillary references, as a matter of necessity must rebroadcast the entire game and the new questions every time the game is played—that is to say, that the applicants' argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., non-live broadcast, periodic update without rebroadcast) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H. Bond whose telephone number is (571) 272-9760. The examiner can normally be reached on M-F 9:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CHB



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